

**REMARKS**

Claims 1-20 are pending. Reconsideration and allowance based on the remarks below are respectfully requested.

**§112 First Paragraph Rejection**

The Office Action rejects claims 1, 7 and 14 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. This rejection is respectfully traversed.

The Office Action alleges that the claim limitation “resetting the infrared communication section” is not supported in the disclosure. The Office Action directs Applicant’s attention to page 14, line 12 which states “image data stored in the memory 24 is deleted” asserting that deletion of the data is not the same or equivalent to resetting the infrared communication section.

In response, Applicant directs the Examiner’s attention to at least page 3, lines 12-17, page 14, line 11, and page 14, line 4 of the specification. Page 3 states “after the protecting means is removed and the image data is taken out from the communication section, by covering the communication section once again with the protecting means so as to return the digital camera to its original state.” On page 14, it states “Then, in the same way as the initial digital camera 10 illustrated in Fig. 1A and 1B and 2, once again, the protection film 36 is affixed to the infrared communication device 14 so as to cover the window 30, and recycling of the digital camera 10 is performed.” Finally, on page 15, it states “by covering the communication section once again with the protecting means so as to set the digital camera in its original state by recycling method of the present invention, the digital camera can be recycled easily.” In at least these sections of the specification, it discloses that the covering of the window 30 (infrared section) causes the digital camera to return to its original state, which is also described as recycling of the digital camera. The returning of the camera to its original state necessarily involves the resetting of the infrared communication section. One of ordinary skill in the art would easily discern that if the infrared communication section was not reset then the camera

could not return to its original state. Although the specification does not specifically use the terminology “resetting the infrared communication system”, Applicant notes that “the failure of the specification to specifically mention a limitation that later appears in the claims is not a fatal one when one skilled in the art would recognize upon reading the specification that the new language reflects what the specification shows has been invented.” *All Dental Prods LLC. v. Advantage Dental Prods, Inc.* 309 F.3d 774; 64 USPQ 2d 1945 (Fed.Cir. 2000). Applicant respectfully submits that one of ordinary skill would readily recognize the claim limitation of “resetting infrared communication section” must be performed when returning the digital camera to its original state and therefore would conclude that the specification provided the teaching of this specific claim limitation.

Therefore, in view of the above, Applicant respectfully requests reconsideration and withdrawal of the rejection.

#### Prior Art Rejection

The Office Action rejects claims 1, 7, 14, 12 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Oswal (USP 6,181,883) in view of Palmer (USP 5,804,829); claims 2, 4, 8, 10, 15 and 17 under 35 U.S.C. § 102(a) as being unpatentable over Oswal, Palmer and Etoh, et al. (USP 5,959,671); claims 3, 9, and 16 under 35 U.S.C. § 103(a) as being unpatentable over Oswal, Palmer and in view of Ando (USP 6,304,724); claims 5, 11, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Oswal, Palmer and in further view of Hatori (JP 410042231A); and claims 6, 13 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Oswal, Palmer, Hatori and Norris (USP 4,523,825). These rejections are respectfully traversed.

Oswal teaches a digital camera that can use an infrared communication port. Oswal does not provide any specific examples of how the infrared communication port would be implemented in Oswal’s digital camera; Oswal merely provides a suggestion that infrared communication can be used. See column 8, lines 45-50. As such, Oswal does not teach an infrared cover nor an infrared cover that when re-covered after an image data is taken out of the

digital camera from the infrared communication section, resets the infrared communication section, as recited in the claimed embodiments of the present invention.

Oswal does teach a hinge cover 76 for an edge connector 78. The hinge cover is not used for an infrared communication section. The Examiner states that the hinge cover corresponds to the claimed removable protection means. Specifically, the Examiner states that “covering the communication section portion of the digital camera with a removable protecting means (hinged cover 76).” Applicant notes that claims 1, 7 and 14 recite an infrared communication section, not an edge connector. Thus, the hinge 76 cannot correspond to Applicant’s protection means, since the hinge cover protects an edge connector not an infrared communication section.

Further, the Examiner states “It would be obvious to one skilled in the art that after the protecting means 76 is removed and the image data is taken out from the communication section and when the hinge cover 78 is once again covered the camera is ready (broadly read as resetting) for taking more pictures.” Nowhere in Oswal does it teach or suggest that a resetting operation of an infrared communication means in a camera is performed when the hinge 76 is re-covered. The Examiner is making an allegation based on hindsight to the Applicant’s disclosure as Oswal does not teach an infrared communication port that includes a protection means nor a resetting operation corresponding to the protection means. The fact that the camera may be ready to take pictures (which Oswal does not teach occurs after replacing the hinged cover) does not imply resetting of an infrared communication means. Again, the only discussion of an infrared device in Oswal is that one could implement the infrared communication in the camera. No other teaching is disclosed.

The Examiner applies Palmer to teach the covering of an infrared communication LED. In Palmer, a portable signal beacon is taught in which an LED emits light and infrared signals. The infrared LED can be covered to provide protection. Nowhere in Palmer does it teach that the re-covering of the infrared LED after sending data, causes the infrared communication LED to reset itself. In fact, the beacon is designed to continue transmitting, not reset itself. Simply stated,

there is no teaching within Palmer of the resetting operation upon re-covering of the infrared LED with the protection means.

Therefore, Oswal and Palmer fail to teach or suggest, *inter alia*, wherein, after the protecting means is removed and the image data is taken out from the communication section, the communication section is once again covered by the protecting means, thereby resetting infrared communication section, as recited in claim 1.

Also, Oswal and Palmer fail to teach or suggest, *inter alia*, a removable protecting means which covers the communication section of the digital camera and is removed at times when the image data is output, thereby resetting the infrared communication section, the protecting means substantially contouring to the outer surface of the communication section, as recited in claim 7.

Also, Oswal and Palmer fail to teach or suggest, *inter alia*, a removable protecting cover which covers the communication section and is removed at times when the image data is output, thereby resetting the communication section, the protecting cover substantially contouring to the outer surface of the communication section, as recited in claim 14.

Further, Etoh, Ando, Hatori and Norris fail to make up for the deficiencies of Oswal and Palmer. Dependent claims 2-6, 8-13 and 15-20 are also distinguishable for at the reasons above as well as for the additional features they recite.

### **CONCLUSION**

For at these reasons, it is respectfully submitted that claims 1-20 are distinguishable over the cited art. Favorable consideration and prompt allowance are earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad J. Billings (Reg. No. 48,917) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

MRC/CJB:lab/cb

By



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